UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROB K. CORELL and SHAWN A. GAITHER

Appeal No. 2006-2891
Application No. 09/436,044

HEARD: Dec. 12, 2006

Before RUGGIERO, BARRY, and MacDONALD, *Administrative Patent Judges.*

BARRY, *Administrative Patent Judge.*

A patent examiner rejected claims 1-15, 18-25, and 30-34. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

I. BACKGROUND

The invention at issue on appeal generates "style sheets" for use with documents written in a markup language. (Spec. at 1.) Style sheets enable separation of the content of a document from its presentation and can give a common look to a collection of documents. A style sheet contains codes, generally but not necessarily found in one document, that specify formatting for the parts of a document such as body text, headings, list items, and quotes. Generally, style sheets and documents exist in electronic form. (*Id.*)

Cascading Style Sheets ("CSS") extend the HyperText Markup Language ("HTML") by enabling precise placement of HTML document elements and precise selection of fonts in HTML documents. A designer of pages for the World Wide Web can use CSS to give a common look and feel to large number of documents. (*Id.*)

Systems exist that can generate a style sheet from a source document. Because such systems are limited to particular file formats (i.e., electronic representations of the source document) or generate style sheets that are specific to the source document, complain the appellants, the systems cannot easily be used to prepare new documents. (*Id.* at 2.)

In contrast, the appellants assert that their invention can generate style sheets from any kind of source document. Once generated, the style sheets can be used to prepare new documents having the same look as the source document. In particular, the invention can generate CSS style sheets from a document generated by an optical character recognition of a scanned document. More specifically, the invention partitions formatted text from the document into groups of words, derives an element style for predefined elements assigned to at least one group of words, and creates an electronic document including a style sheet defining each of the element styles. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim.

1. A method comprising:

receiving a formatted document, the formatted document having formatted text comprising a plurality of words, each word comprising one or more characters, each character having a character appearance defined by one or more font properties and each word having a word appearance defined by the font properties of its characters, the formatted document being formatted on one or more pages, and each word having a position relative to one of the one or more pages;

partitioning the formatted text into a plurality of groups of words based on the positions of the words relative to their respective pages, the font properties of the words, or both;

assigning an element from a predefined set of markup language elements to each of two or more groups in the plurality of groups of words, the assigning being based on the positions of the words relative to their respective pages, the font properties of the words, or both;

after the element is assigned to each of two or more groups of words, deriving an element style for the assigned element, the element style comprising a character style, a layout style or both, the character style being derived from the font properties of the characters of the words in the two or more groups of words to which the element is assigned, and the layout style being derived from the text properties of the two or more groups of words to which the element is assigned; and

creating an electronic document comprising a style sheet defining the element style.

Claims 1-15, 18-25, and 30-34 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,088,711 ("Fein").

II. OPINION

"Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on a point of contention therebetween." *Ex parte Sienel*, No. 2005-2429, 2006 WL 1665423, at *1 (B.P.A.I. 2006). The examiner makes the following assertions.

> [I]n Fein it is indeed possible for an element (i.e. a header) to be assigned to two separate paragraphs but a style for the header to be derived after a header has been assigned to at least two paragraphs. In columns 11-12, Fein teaches that an appropriate style for a paragraph can be defined by determining whether the paragraph type is a header or body text, etc. If a heading has a certain text characteristic or point size, then it is assigned a "heading style". See columns 11-12.

(Examiner's Answer at 11.) The appellants argue, "In Fein, a style already has been defined based on only one paragraph before Fein assigns the style to a second paragraph, and assigning a defined style to a second paragraph does not satisfy the limitation of deriving a style from multiple groups of words." (Appeal Br. at 4.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious."

Ex Parte Cuomo, No. 2003-0509, 2004 WL 4978831, at *2 (B.P.A.I. 2004).

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following limitations:

> assigning an element from a predefined set of markup language elements to each of two or more groups in the plurality of groups of words, the assigning being based on the positions of the words relative to their respective pages, font properties of the words, or both;
>
> after the element is assigned to each of two or more groups of words, deriving an element style for the assigned element. . . .

Claim 21 includes similar limitations. Considering all the limitations, the independent claims require deriving an element style for an assigned element after the element has been assigned to each of at least two groups of words.

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004). The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, "[b]riefly described, [Fein's] invention provides a method and system for automatically applying a style to a paragraph in a document. An existing

style may be applied to the paragraph. A new style may also be defined and applied to the paragraph if the paragraph does not match an existing style." (Col. 6, ll. 36-42.) More specifically, "a paragraph type of the paragraph is identified and, based upon the paragraph type, a determination is made whether there is an appropriate style to define. The paragraph type is a general, functional description of the paragraph. For example, the paragraph type may be a heading or body text." (Col. 3, ll. 4-10.) "[T]hen the major formatting properties and the minor formatting properties of the paragraph are stored in association with the appropriate style to define the appropriate style. The defined style may then be applied to the paragraph." (*Id.* at ll. 13-17.)

Observing that "[a] paragraph is comprised of a 'group of words,'" (Examiner's Answer at 10), the examiner reads the claim's "groups of words" on the reference's paragraphs. Although Fein identifies types of paragraphs and defines styles for those paragraphs, as aforementioned, we cannot find that such styles are defined for a type after the type has been assigned to each at least **two** paragraphs. To the contrary, we find that the reference identifies types and defines styles for paragraphs **one at a time**. For example, the aforementioned parts of Fein teach that "**a** paragraph type of **the** paragraph is identified," (col. 3, ll. 4-5 (emphases added)), and a "new style may also be defined and applied to **the** paragraph if **the** paragraph does not match an existing style." (Col. 6, ll. 40-42 (emphases added.)

Absent a teaching or suggestion of deriving an element style for an assigned element after the element has been assigned to each of two or more groups of words, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the obviousness rejection of claims 1 and 21 and of claims 2-15, 18-20, 22-25, and 30-34, which depend therefrom.

III. CONCLUSION

In summary, the rejection of claims 1-15, 18-25, and 30-34 under § 103(a) is reversed.

REVERSED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
)
)
)
) BOARD OF PATENT
LANCE LEONARD BARRY) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)
)
ALLEN R. MACDONALD)
Administrative Patent Judge)

FISH & RICHARDSON P.C.
P.O. Box 1022
MINNEAPOLIS MN 55440-1022